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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/619,428

07/16/2003

Takasuke Nakanishi

KAN-001 (10029)

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02/13/2009

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EXAMINER

MENDOZA, MICHAEL G

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

02/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/619,428

**Applicant(s)**

NAKANISHI, TAKASUKE

**Examiner**

MICHAEL G. MENDOZA

**Art Unit**

3734

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/12/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-4, 7, and 9 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments filed 11/12/2008 have been fully considered but they are not persuasive. In regards to claim 5, the applicant has not amended the claim. The previous rejection to Simpson is maintained.
3. Claims 1-5 and 7-9 are pending. Claim 8 is withdrawn from consideration.

### ***Claim Objections***

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 5 merely reiterates the structure of the cutting tool previously set forth in claim 1. It is further noted that "a cutting tool for use in the medical handpiece of claim 1" is an improper dependent claim because it fails to meet the infringement test since one could conceivably infringe upon the cutting tool without infringing on the medical handpiece. See MPEP 608.01(n)III

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

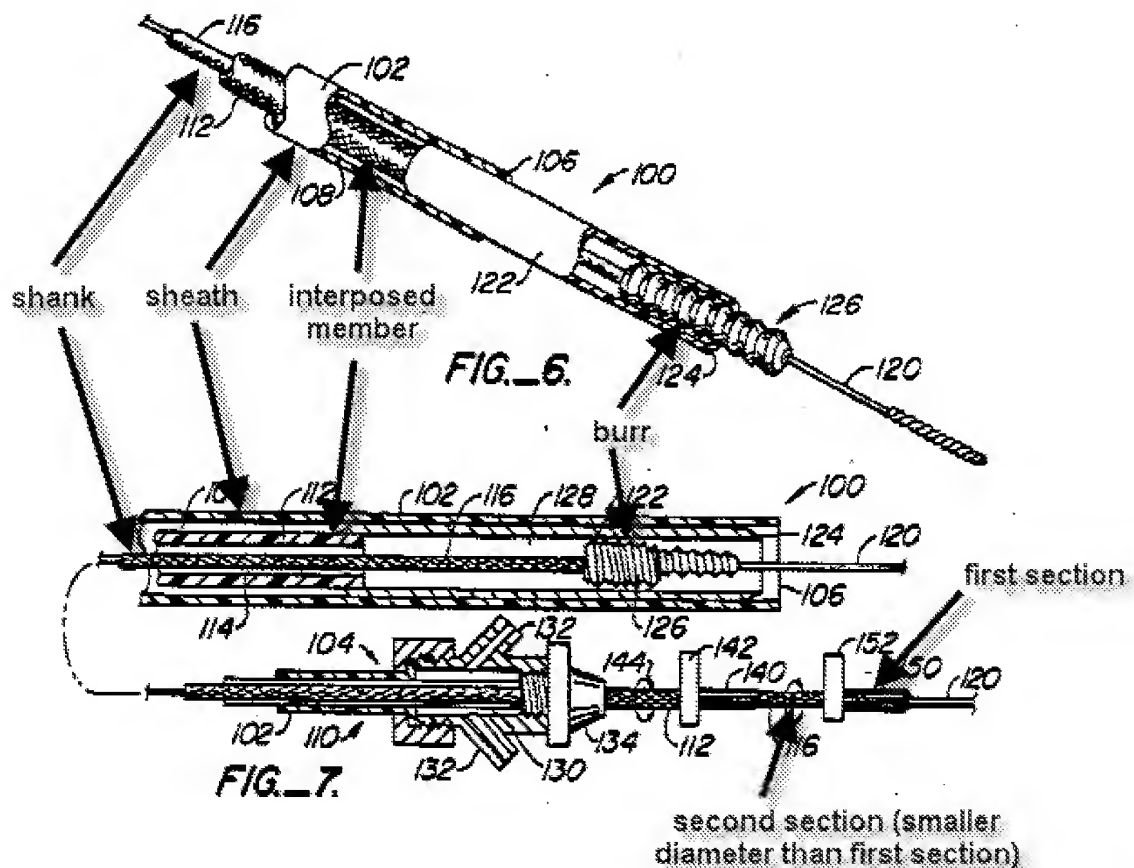
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Simpson et al.

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6. Simpson et al. teaches a cutting tool comprising : a burr; an elongate flexible shank; a bearing contact portion; wherein the shank has a first section to be chucked in a handpiece body of the medical handpiece, and a second section having a diameter smaller than the diameter of the first section and having sufficient flexibility to be elastically deformed more easily than the first section.



***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of Barber 4541423.

9. Simpson et al. teaches a medical handpiece for cutting a treatment site, comprising: a cutting tool having an elongate flexible shank and a burr; a generally tubular sheath; an interposed member interposed between the elongate tube portion of the sheath and the shank of the cutting tool; a hand piece body; wherein the elongate tube portion of the sheath is malleable and deformable, and the shank of the cutting tool and the interposed member are deformable following malleable deformation of the elongate tube portion; and wherein the shank has a first section in a handpiece body, and a second section having a diameter smaller than the diameter of the first section having sufficient flexibility to be elastically deformed more easily than the first section; wherein the interposed member is tubular and flexible; wherein the interposed member is made of a fluororesin (col. 9, lines 44-47). It should be noted that Simpson et al. fails to teach wherein the sheath is malleable and deformable into a desired curved shape by applying force with a hand or fingers, and the curved shape is maintained in the absence of external force.

10. Barber teaches a device with a common malleable sheath for selecting a desired curvature. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Simpson et al. to include the sheath in view

of Barber for drilling a curved hole to avoid the drilling of two intersecting holes to reach a surgical site (col. 1, lines 21-33).

11. Simpson/Barber teaches wherein the shank has a first section chucked in handpiece (col. 3, line 56-col. 4, line 2, col. 4, lines 12-28).

12. As to claim 7, Simpson/Barber discloses the claimed invention except for the wall thickness range of the elongate tube portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed range, since it has been held that wherein the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

13. As to claim 9, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson/Barber as applied to claim 1 above, and further in view of Brown 6514258.

15. Simpson/Barber does not expressly disclose that his cutting tool has a marker that matches a marker of the same color of the sheath. However, Brown discloses that it is well known in the art to use markings on surgical tools to help the clinician know which bits to connect and the corresponding length of the cutting tool. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use matching color markings, as disclosed by Brown, on the surgical device disclosed by Simpson/Barber in order to help the clinician connect the correct cutting tool with the correct sheath or handpiece.

***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. MENDOZA whose telephone number is (571)272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. G. M./  
Examiner, Art Unit 3734

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734